

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:  
William Y. Conwell

Application No.: 09/670,113

Filed: September 26, 2000

For: METHOD OF PROCESSING TEXT  
FOUND IN IMAGES

Examiner: S. Patel

Date: January 17, 2006

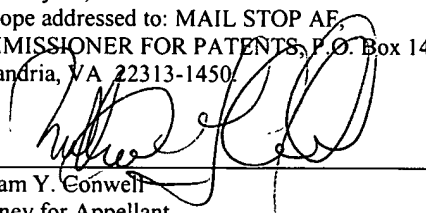


Art Unit 2621

Confirmation No. 4862

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on January 17, 2006 as First Class Mail in an envelope addressed to: MAIL STOP AF, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450.

  
William Y. Conwell  
Attorney for Appellant

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP AF  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellant requests review of the appealed-from rejection in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

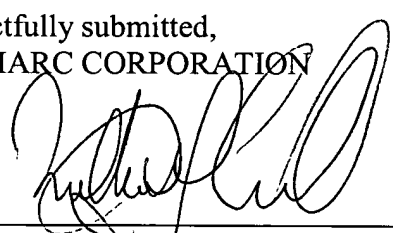
Date: January 17, 2006

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Respectfully submitted,  
DIGIMARC CORPORATION

By

  
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# REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW



The Board will reverse the rejections. A few reasons for reversal are noted below.

Claim 3, 5, 16, 18-20 and 23 stand rejected under § 102 over Li (5,506,697).

Each of these claims requires “encoding a watermark” (or a “watermarker that alters an output from said apparatus to encode a watermark therein”). Li does not teach such any such watermark encoding.

The item denoted by reference numeral 45 in Li’s Fig. 3 is a bar code. This bar code is more particularly shown in Li’s Fig. 2. This item is not a watermark:



FIG. 2

The present specification incorporates-by-reference a prior application 09/503,881 for its teachings on watermarks.<sup>1</sup> (That application is now patent 6,614,914, and was submitted with the IDS filed 2/5/04.) That document makes clear that one of the attributes of a watermark is that it is essentially imperceptible. For example, that incorporated-by-reference document states:

- *“The embedder encodes a message into a digital signal by modifying its sample values such that the message is imperceptible to the ordinary observer in output form.”<sup>2</sup>*
- *“Generally, the perceptual analysis employs a HVS model to identify signal frequency bands and/or spatial areas to increase or decrease watermark signal intensity to make the watermark imperceptible to an ordinary observer.”<sup>3</sup>*
- *Digital watermarking technology allows the user to embed digital messages within media content. These digital messages are imperceptible to humans but can be read by computers and specialized devices.<sup>4</sup>*

<sup>1</sup> See paragraph bridging pages 1 and 2 in the present specification – updated to include issued patent number in amendment filed February 5, 2004.

<sup>2</sup> Patent 6,614,914, col. 6, lines 54-56, *emphasis added*.

<sup>3</sup> Patent 6,614,914, col. 12, lines 10-14, *emphasis added*.

<sup>4</sup> Patent 6,614,914, col. 35, lines 2-5, *emphasis added*

The Federal Circuit, in its recent Philips *en banc* decision, reiterated longstanding precedent, stating: “*The specification is, thus, the primary basis for construing the claims.*”<sup>5</sup>

The meaning of the term “watermark” in appellant’s claims must proceed primarily from the specification. Only if the specification does not guide interpretation of the term should extrinsic sources be given primacy.

In the present case, an artisan would understand from the specification that a watermark is essentially imperceptible. The bar code taught by Li would not be understood by an artisan as a watermark. (The Examiner concedes Li’s element 45 is perceptible.<sup>6</sup>)

In a discussion of a particular application of watermarking – associating a URL with a printed document – appellant’s incorporated-by-reference specification emphasized one of the advantages that an imperceptible marking provides – it preserves the aesthetics of the marked media object, preserving quality:

*Embedding imperceptible digital watermarks offers several advantages over printing the URL on an advertisement. First, using digital watermarks does not require any real estate of the image and thus preserves the image quality. Presenting the URL on the image consumes some of the image's valuable real estate and degrades image quality.*<sup>7</sup>

It will be recognized, again, that Li teaches an opposite arrangement. An artisan following Li’s teaching would be left with a document bearing an unsightly pattern of black and white lines – detracting from the document’s original quality. (See document 20 in Li’s Fig. 1.)

Since Li fails to teach a watermark, it cannot anticipate any of appellant’s claims requiring the claimed watermark.

The Examiner is correct that he should interpret the claim language as broadly as possible.<sup>8</sup> But he may not construe it in a manner contrary to its meaning given by the specification. That violates the Federal Circuit’s holding in *Philips*. And that is what has been done here.

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<sup>5</sup> *Philips v. AWH Corp.*, Nos. 03-1269, 03-1286 (Fed. Cir. July 12, 2005), slip op. at 14, citing *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985).

<sup>6</sup> November 15, 2005, Final Rejection, page 2, middle of page.

<sup>7</sup> Patent 6,614,914, col. 40, lines 8-13.

<sup>8</sup> November 15, 2005, Final Rejection, page 2, 7 lines from bottom.

Li is also applied in all of the § 103 rejections – for its alleged teaching of encoding a watermark, etc. However, as indicated above, Li does not teach any watermark. Accordingly, the § 103 rejections fail because the art – even if combined as proposed – cannot yield the claimed combinations.

There are other comments and points of distinction that may be made concerning the art, the claims, and the rejections. However, the foregoing points are believed sufficient to establish that the rejections will be reversed by the Board.